

09/244,190

RCE and Amdt. Dated May 24, 2004

Second Reply to Final Rejection of Dec. 23, 2003

Following Advisory Action of April 8, 2004

REMARKS

In conjunction with the accompanying request for continued examination (RCE), this response is submitted in response to the Final Office Action dated December 23, 2004 and to the Advisory Action of April 8, 2004.

This response replaces the Response After Final Rejection Under 37 CFR §1.116 filed on March 22, 2004 and entered by way of the Advisory Action.

Reconsideration of this application is respectfully requested.

The applicant filed a response on October 7, 2003 to the Office Action of July 9, 2003. The Final Office Action of December 23, 2003 is in reply to the applicant's response of October 7, 2003.

Previously, in the Response After Final Rejection Under 37 CFR 1.116 filed on March 13, 2003 to the Final Office Action of January 8, 2003, the applicant had amended claims 1 and 10 to add the limitation of displaying simultaneously the old and new messages as follows:

Claim 1: --displaying simultaneously said new message on said display unit in a second display attribute different from said first display attribute.—

Claim 10: -- for displaying a new message simultaneously on said display unit in a second display attribute different from said first display attribute when said new message is received by said message receiving unit during the display of said messages.--

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In the Office Action of July 9, 2003, the Examiner issued a rejection under 35 U.S.C. 112, first paragraph, of claims 1-18 alleging that the addition of the limitation "simultaneously" introduced new matter into the application.

In the applicant's response of October 7, 2003, the applicant presented arguments citing portions of the specification that were intended to counter the Examiner's rejection of claims 1-18 under 35 U.S.C. 112, first paragraph, as introducing new matter into the application.

In the instant Final Rejection of December 23, 2003, the Examiner indicates the following:

35 U.S.C. 112, First Paragraph: Claims 1-18

The Examiner has rejected claims 1-18 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner alleges that the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, has possession of the claimed invention.

The Examiner alleges that support for the limitation to simultaneously display could not be found in the specification as originally filed. The Examiner concedes that the applicant did point to the specification for support. However, the Examiner indicates that the specification states that "...which the user has viewed

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until then.." implies that the view of the old message is no longer presented and therefore, support for simultaneous display is lacking.

The Examiner also states in the Response to Arguments that the applicant's arguments filed on October 9, 2003 regarding the 35 U.S.C. 112, first paragraph rejection have been fully considered but the Examiner alleges that they are not persuasive. The Examiner concedes that the applicant pointed to other portions of the specification but the Examiner asserts that like other portions of the specification, this does provide support for first displaying one message and then displaying a next message.

In the response of March 22, 2004, the applicant amended claims 1 and 10 to delete the limitation of "simultaneously".

In the Advisory Action, the Examiner entered the amendment to claims 1 and 10 to delete the limitation of "simultaneously". However, the Examiner maintains that the amendment does NOT place the application in condition for allowance because the amendment filed on March 22, 2004 places the claims in essentially the same condition as they stood prior to the amendment filed on March 13, 2003. The Examiner maintains that therefore, the prior art rejections detailed in the Office Action of July 9, 2003 are now applicable. The Examiner further maintains that by eliminating the "simultaneous" limitation, the reference Amma is not necessary and the perfected priority cannot overcome the other prior art references. (In effect, the rejections now stand as detailed in the Final Rejection of January 8, 2003).

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In response, prior to addressing the rejections over the prior art, the applicant directs the Examiner's attention to the fact that claims 1 and 10 have been cancelled without prejudice. The applicant has not abandoned the subject matter of claims 1 and 10, and reserves the right to file a continuation application directed thereto.

Method claim 4 and analogous apparatus claim 13 have been rewritten into independent form, incorporating the limitations of base claims 1 and 10, respectively, while adding the following limitations have been added to rewritten claim 4:

--said stored messages including a message being read immediately before receipt of said new message-- and

--restoring said message being read immediately before receipt of said new message--.

Analogous limitations in an apparatus format have been incorporated into rewritten now independent claim 13. Minor editorial changes have also been made to claims 4 and 13. The amendments to claims 4 and 13 have been made to enhance the recitation of the limitations of the present invention.

Corresponding changes have been made to the dependencies of claims 2, 3, 11, 12 and 16, as shown in the Amendments to the Claims. Claims 2 and 3 now depend from claim 4 instead of cancelled claim 1. Claims 11, 12 and 16 now depend from claim 13 instead of cancelled claim 10.

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The applicant has also made minor editorial amendments to claims 9, 15 and 18 to improve claim form.

Support for the amendments to claims 4 and 13 is found in FIG. 3, which discloses item 104 "Message #M", item 105 "Latest Message", and item 106 "Message #M".

The specification discloses on page 12, lines 7-14:

When the user attempts to view the next message to input a display continuation instruction from the operation unit, the control returns to the message display state in which the user had viewed last. That is, following the latest message, the message #m (106), a message #m+1 (107), a message #m+2 (108) ... are displayed in the described order.

The specification discloses on page 20, lines 18-24:

Furthermore, when the user desires to read the message next to the latest message, the user can read the message #m which has been read immediately before the latest message.
This eliminates the inconvenience of having to repeatedly read the messages which the user has read once.

In view of the foregoing, no new matter has been added to claims 4 and 13 nor to claims 2, 3, 9, 11, 12, 15, 16 and 18.

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35 U.S.C. 103(a) Rejections: Claims 1-18

As noted in the Advisory Action, the Examiner states that the prior art rejections detailed in the Office Action of July 9, 2003 are again applicable, except for the removal of the Amma reference. In effect, the Examiner's basis for the rejections is again as detailed in the Final Rejection of January 8, 2003. That is, the Examiner rejects claims 1, 2, 10 and 11 under 35 U.S.C. § 103(a) allegedly as being unpatentable over Bennett et al (US 5,965,569 – filed March 14, 1989 – issued October 23, 1990), and either Sone (US 5,793,304 – filed July 16, 1996 – issued August 11, 1998) or Burgan et al (US 6,166,621 – filed January 29, 1998 – issued December 26, 2000) or McLaughlin et al. (US 4,975,694 – filed March 14, 1989 – issued December 4, 1990).

In view of the Advisory Action of April 8, 2004 and the Office Action of July 9, 2003 and the Final Rejection of January 8, 2003, the Examiner rejects claims 3 and 12 under 35 U.S.C. § 103(a) allegedly as being unpatentable over Bennett, Sone, Burgan et al and McLaughlin et al and further in view of Fennell (US 5,430,436 – filed July 22, 1994 – issued July 4, 1995). .

Similarly, the Examiner now rejects claims 4-9 and 13-18 under 35 U.S.C. § 103(a) allegedly as being unpatentable over Bennett, Sone, Burgan et al and McLaughlin et al and further in view of Nakajima (US 4,477,807 – filed June 4, 1982 – issued October 16, 1984).

In response, the applicant maintains that none of the prior art references cited by the Examiner of Bennett et al and either Sone or Burgan et al or

McLaughlin et al or Fennell or Nakajima disclose, teach or suggest the limitations of claim 4 of a method of displaying messages in a selective call radio apparatus of

--said stored messages including a message being read immediately before receipt of said new message—and --restoring said message being read immediately before receipt of said new message--;

nor do the prior art references disclose, teach or suggest the limitations of claim 13 of a selective call radio apparatus wherein --stored messages including a message being read immediately before receipt of said new message,-- and --said control unit restores said message being read immediately before receipt of said new message--.

Consequently, claims 2 and 11 patentably distinguish over Bennett et al and either Sone or Burgan et al or McLaughlin et al taken alone or in combination.

Similarly, claims 3 and 12 patentably distinguish over Bennett, Sone, Burgan et al and McLaughlin et al and further in view of Fennell, taken alone or in combination.

Finally, claims 4-9 and 13-18 patentably distinguish over Bennett, Sone, Burgan et al and McLaughlin et al and further in view of Nakajima, taken alone or in combination.

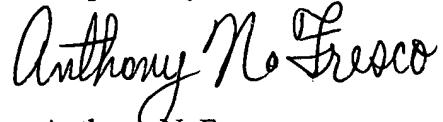
As a result, the applicant respectfully requests that the Examiner withdraw the rejections of claims 2-9 and 11-18 over the prior art.

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Reconsideration of this application in view of the foregoing Amendment and Remarks is respectfully requested. The foregoing Remarks establish the patentable nature of all of the claims remaining in the application, i.e., claims 2-9 and 11-18. No new matter has been added. It is respectfully submitted that this application is in condition for allowance. Accordingly, early and favorable reconsideration and issuance of a Notice of Allowance are respectfully requested.

Respectfully submitted,



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